

# SHAW KELLER LLP

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**BY CM/ECF**

The Honorable Jennifer L. Hall  
United States District Court for the District of Delaware  
844 N. King Street  
Wilmington, DE 19801

Re: *3Shape A/S v. Align Technology, Inc.*, C.A. No. 18-886-LPS (Consolidated)

Dear Judge Hall:

The parties hereby submit this proposal for scheduling in this action, as directed by the Court at the February 10, 2020 teleconference (D.I. 89).

The parties agree that the patents asserted in Align's counterclaims in this action (*i.e.*, U.S. Patent Nos. 10,507,088, 10,507,089, 9,675,430) should be severed from this action and consolidated with Align's complaint in C.A. No. 18-1949-LPS. Coincident with the addition of these three new patents to the 18-1949 action by stipulated amended complaint, Align will dismiss without prejudice its currently asserted U.S. Patent Nos. 7,357,634, 8,359,115, and 8,805,563 from that case, and 3Shape will dismiss without prejudice its currently-asserted counterclaims regarding U.S. Patent Nos. 7,357,634, 8,359,115, and 8,805,563.

This reorganization will eliminate the need for a separate trial on Align's counterclaim patents in this case, reducing the burden on the Court and the parties. It will also reduce the overall number of patents asserted between the parties. Finally, Align's counterclaim patents can be prosecuted in the 18-1949 action without disruption of the schedule in that case, thus ensuring the smooth integration of the patents into an existing case without creating the need for another discovery schedule and trial in a later action involving these parties.

Because the 18-1949 action is in its infancy, the parties agree that no adjustment to the overall schedule is necessary.

The parties believe that this is a suitable approach as it will reduce the overall number of trials in this Court and keep all cases moving on an acceptable timeframe. In addition, the parties believe that this approach is consistent with Your Honor's guidance on the February 10, 2020 call. (*See* Feb. 10, 2020 Telecon. Tr. at 22:4-14 ("THE COURT: . . . So if Align wants to try to bump one of the other trials it has scheduled or add these to one of those other trials, that could be something that the Court would be amenable to, but I am not in a position to be able to rule on that today.")).

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Counsel remains available should the Court have any questions. If the Court approves of the parties' proposal, Align will file an amended complaint consistent with the above and the parties will file a stipulation for dismissal without prejudice consistent with the above.

Respectfully,

*/s/ Jeff Castellano*

Jeff Castellano (No. 4837)

cc: Clerk of the Court (by hand delivery)  
All counsel of record (by e-mail)